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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/637,130	08/08/2003	Janel Lanphere	01194-465001 / 03-347	3843
26161	7590	05/15/2007	EXAMINER	
FISH & RICHARDSON PC			LE, HOA T	
P.O. BOX 1022			ART UNIT	PAPER NUMBER
MINNEAPOLIS, MN 55440-1022			1773	
			MAIL DATE	DELIVERY MODE
			05/15/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/637,130

Applicant(s)

LANPHERE ET AL.

Examiner

H. T. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-8,11-20,22-30 and 41-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-8,11-20,22-30 and 41-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date Nov. 07, 2005
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Information Disclosure Statement***

2. The information disclosure statement filed November 07, 2005 has been made of record. Some of the references cited have not been considered in the merits because they appear to be irrelevant to the claimed subject matter. It is not helpful to consider references that are irrelevant because it would hinder the public from finding useful relevant references if having to wade through numerous irrelevant references. If Applicant wishes for any of these references to be considered, re-submission of the reference(s) along with a concise statement of its relevancy to the claimed subject matter is required.

#### ***Response to Arguments***

3. **Claims 1, 2, 5-8, 11, 13, 14, 18-30, 41-45, 48-51, and 54-58 are rejected under 35 U.S.C. 102(b) as being anticipated by Mangin (WO 01/66016) as set forth in the last office action and further discussed below.**

Claims have been amended to cancel claims 3 and 4 and to include the limitations of the canceled claims into the independent claim 1.

- 2.1. Applicant argued that “the Examiner has not satisfied the requisite legal standard because the Examiner has not established that a person of ordinary skill in the art would recognize that Mangin necessarily discloses particles wherein the average pore size in the interior region is greater than the average pore size at the surface region.” Contrary to

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Applicant's allegation, the Examiner has clearly identified the teaching of Mangin that anticipates the pore density as well as pore size claim features. In the previous office action, it's stated that the claim features are shown in figures 1A and 1B and reinforced by the method disclosed at page 8, lines 17-25 of the Mangin publication. Such method which involves oil-in-water emulsification and incubation of the emulsification to leech out the soluble material (page 8, lines 17-25) inherently results in larger pores generated in the interior region than in the surface region. See last office action, page 2, second paragraph. Furthermore, Mangin also discloses a method that could result in a hollow interior particle (page 8, lines 31-35). In a hollow particle, it is necessarily inherent that the density of the surface region must be larger than that of the interior region and that the interior region has larger average pore size than that the average pore size in the surface of the particle. Thus, a person of ordinary skill in the art would recognize that Mangin necessarily discloses particles having the porosity structure as claimed.

2.2. Applicant argued "based on Figs. 1A and 1B of Mangin, it would appear that the surface region of Mangin's particle has more larger pores than the interior region of Mangin's particle, indicating that the average pore size in the interior region of Mangin's particle is less than the average pore size at the surface region. Note that figure 1A shows the surface of the particle while figure 1B shows the cross section of the particle. And from the cross-section as show in figure 1B, it can be extrapolated that the interior, which includes multiple of such cross sections, would have at least twice as larger pores as the number of larger pores on the surface.

4. **Claims 12, 15-17, 46, 47, 52 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mangin (WO 01/66016) as set forth in the last office action and further in view of the discussion below.**

3.1. Applicant argued that there is no “suggestion to modify Mangin to provide the particles covered by claims 1, 2, 4-8, 11-20, 22-30, and 41-58” because “according to Mangin his particle satisfies his perceived need”. Claims 12, 15-17, 46, 47, 52 and 53 describe features that would have been attained through routine experimentation in making embolic particles. Here, Mangin teaches that his particles are useful for embolization application; therefore, one of ordinary skill in the art would have arrived at the features as recited in claims 12, 15-17, 46, 47, 52 and 53 through routine experimentation in making the embolic particles within the specification of Mangin.

### ***Conclusion***

5. Applicant's arguments filed February 15, 2007 have been fully considered but they are not persuasive for the reasons set forth above.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee

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pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action.

In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to H. T. Le whose telephone number is 571-272-1511. The examiner can normally be reached on 10:00 a.m. to 6:30 p.m., Mondays to Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



H. T. Le  
Primary Examiner  
Art Unit 1773

May 9, 2007